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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/904,843

07/16/2001

Nobuhiko Kitamura

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08/10/2006

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EXAMINER

BEKERMANN, MICHAEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,843

Applicant(s)

KITAMURA, NOBUHIKO

Examiner

Michael Bekerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11,13-17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11,13-17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to papers filed on 5/26/2006.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Goodman (U.S. Patent No. 4,720,873).** Goodman teaches a system for transmitting advertisements over a network that includes all of the limitations recited in the above claim.

Regarding claim 13, Goodman teaches a network selling advertising space that provides an advertising rate table arranged according to a providing time for the advertisement (Column 12, Lines 17-20). The rate table is inherently sent to the source of the advertising data.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 2, 9, 10, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusumoto (U.S. Patent No. 6,954,728).**

Regarding claims 1, 2, 9-10, and 14-17, Kusumoto teaches various ways of charging an advertiser for sending an advertisement over a network. These rates can vary depending on such factors as "hours of the day during which avatars display the advertisement" and "number of times a particular advertisement was selected". (Column 9, Lines 16-24). Kusumoto also teaches a billing support system for calculating a fee to be sent to the advertisers based on the factors above (Column 9, Lines 25-29). Receiving of advertising data from the advertiser is inherent. Kusumoto teaches interactive media (interactive media includes websites) being used over a network to display advertisements to users and an advertising rate being charged to an advertiser based on number of access to the data. Kusumoto doesn't specify a placing charge as being lowered as number of accesses increases. **The law of supply and demand states that as supply increases (number of accesses), price will decrease (placing charge). Official notice is taken that the law of supply and demand is old and well known in the field of business.** It would have been obvious to one having ordinary skill in the art at the time the invention was made to decrease the placing charge as the number of accesses to the data increases. This would give the web page provider incentive to drive more traffic to the website.

3. Claims 4, 5, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusumoto (U.S. Patent No. 6,954,728) in view of Brody (U.S. Pub No. 2002/0077694).

Regarding claims 4, 5, and 20, Kusumoto doesn't teach varying an advertisement rate according to the amount of advertising space occupied by the advertising data within the interactive environment. Brody teaches merchants as paying higher amounts for bigger advertisements on a web page (Paragraph 0075, Sentence 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made for Kusumoto to charge more money for an advertisement that takes up more space. This would allow Kusumoto to make more money. As the number of accesses increases, Kusumoto teaches the advertiser as paying more. Brody teaches the amount of advertising space as increasing the more the advertiser pays. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Kusumoto's advertisements to increase in size as the advertiser pays more, as taught by Brody. This would give advertisers more for their money.

4. Claims 6, 11, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusumoto (U.S. Patent No. 6,954,728) in view of Rinebold (U.S. Patent No. 6,968,513).

Regarding claims 6, 11, and 19, Kusumoto doesn't teach varying an advertisement rate according to geographical location. Rinebold teaches charging

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advertising fees based on geographic locations (Column 4, Lines 31-42). It would have been obvious to one having ordinary skill in the art at the time the invention was made for Kusumoto to charge more money for an advertisement based on geographic location. This would allow Kusumoto to make more money.

Claims 7, 8, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusumoto (U.S. Patent No. 6,954,728) in view of Goldhaber (U.S. Patent No. 5,794,210).

Regarding claims 7 and 8, these claims follow a similar rejection as that of claim 1. Kusumoto doesn't teach sending accounting data to a user computer. Goldhaber teaches charging a consumer for provided information (Column 19, Lines 57-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made for Kusumoto to charge the first computer for viewing the provided advertising information. This would allow Kusumoto to make more money.

Response to Arguments

5. **Regarding the 103(a) rejection of canceled claim 3 (now amended into claim 1)**, applicant argues "the office action relies on impermissible hindsight" and "no reference is provided by the office action to support its alleged basis for obviousness". Examiner submits that he did use a reference (which is now bolded in the above rejection). The law of supply and demand is an old and well-known law of Economics.

Anyone skilled in the art of business would be familiar with this principle, and would find it obvious to combine with Kusumoto.

6. **Regarding the 102(b) rejection of claim 13**, Applicant argues that “there is no disclosure or suggestion that the system of Goodman provides the advertising charge table to the source of the advertising data”. Examiner asserts that this is an inherent feature. The advertiser would inherently receive a listing of charges for placing the advertising data.

New art has been added to the rejections of the other amended claims.

Therefore, this application remains unpatentable over the applied prior art.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JEFFREY D. CARLSON
PRIMARY EXAMINER

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